

### **REMARKS/ARGUMENTS**

#### **Status of the Claims.**

Claims 1-9, 16-64 are pending.

#### **The Present Amendments**

No new matter is added by the present amendments.

Claim 1 has been amended by moving the recitation that the gloss coatings stabilize at a high gloss value from the end of the claim to the beginning to avoid having it be read as an optional feature of the coatings. The recitation itself is supported throughout the specification, including specification page 7, paragraph 16, and page 25, paragraph 77.

#### **The Office Action**

The Office Action dated September 4, 2007 (the "Action") rejects the claims on several grounds. Applicants amend in part and traverse the rejections. For the reader's convenience, the rejections are addressed below in the order in which they are presented in the action.

#### **1. Rejection of claims as obvious over U.S. Patent No. 6,869,628**

The Action maintains the rejection claims 1-9 and 16-64 under 35 U.S.C. § 103(a) as obvious over Krochta, U.S. Patent No. 6,869,628 (the "'628 patent"). The Action indicates that the Terminal Disclaimer filed with the last amendment and Applicants statements filed therewith did not overcome the rejection because the statement did not specify that there was common ownership between the present application and the patent at the time of the invention.

A review of rule 1.130 indicates that a commonly owned patent can be disqualified as prior art by submission of a terminal disclaimer and by a declaration declaring that the application under examination and the patent cited against it are currently owned by the same party, and that the inventor named by the application is the prior inventor. As noted, a terminal disclaimer over the '628 patent has already been submitted. An unsigned declaration by

inventor John M. Krochta accompanies this Amendment. In his declaration, Dr. Krochta states that the application and the '628 patent are commonly owned and that both he and inventor Kirsten Dangan are prior inventors. A signed copy of the Declaration will be submitted as soon as it is available. Accordingly, it is believed that the requirements of §1.130 have been met. Reconsideration and withdrawal of the rejection are respectfully requested.

Since this rejection is the only one applied by the Action against claims 55-64, Applicants believe that the terminal disclaimer and declaration place claims 55-64 in condition for allowance.

## **2. Rejection of claims as anticipated by or obvious over McCabe**

### **A. Anticipation.**

Claims 1-2, and 6-9 are rejected under §102(e) as anticipated by McCabe, U.S. Patent No. 6,830,766 hereafter, "McCabe". According to the Action, the arguments concerning gloss made by the Applicants in the last amendment did not overcome the previous rejection because gloss was an optional feature of the invention as claimed.

For the sake of good order, Applicants note that the amendment of claim 1 made the presence of a lipid optional, but the recitation that the coatings stabilize at a high gloss value applied to the entirety of the claim. To remove any possibility with respect to the intended reading of the claim, claim 1 has been amended to recite that the coatings of the invention have a high gloss when applied to the solid surface of a food as an aqueous solution and then dried. The reference to solid surfaces is intended to clarify that the coatings are intended for use on foods with surfaces on which the coating solution can be dried. That the coatings provide a gloss was already recited in the claim preamble, but the further recitation is intended to remove any doubt that the recitation of gloss is a functional limitation. To the extent that the present rejection was founded on high gloss being an optional feature of the claim, it should be reconsidered and withdrawn.

### **B. Obviousness**

Claims 1-9, 16, 17, 20-22, 24-31, 35-37, 39-44, 47-49, and 51-54 are rejected under 35 U.S.C. § 103(a) as obvious over McCabe.

The rejection states that "Applicants' arguments relating to the extent of gloss in the product does not overcome the rejection because the gloss appears to be an optional feature in the claims." Action, at pages 4-5. As noted above, claim 1 has been amended to recite gloss as a functional recitation. Accordingly, to the extent the rejection is based on gloss being merely an optional aspect of the claimed coatings, it should be reconsidered and withdrawn.

The Action further contends that "the ingredients of the claims are fully disclosed by McCabe." Action, at page 4. As noted in the last Amendment, however, they are not disclosed in McCabe in combinations that would result in formation of a coating with gloss. McCabe neither teaches or suggests how to modify its coatings to provide gloss. Accordingly, once more, to the extent the rejection is based on gloss being merely an optional aspect of the claimed coatings, it should be reconsidered and withdrawn.

### **3. Rejection of the claims as obvious over Best**

Claims 1-9 and 16-54 are rejected under §103(a) as obvious over Best, U.S. Published Application 2005/0118311 ("Best").

According to the Action, "Best discloses [a] reduced fat flavored coating made from a combination of sugar and hydrocolloid. The hydrocolloid may include protein." The Action further contends that, contrary to the arguments made in the previous amendment, that Best discloses glossy coatings at the end of paragraph 0008. Action, at pages 5-6, bridging sentence. Best's actual statement at the end of paragraph 0008 is: "The coating of the invention is also typically glossy in substantially the same manner as chocolate." As Applicants pointed out in the previous amendment, this statement is at best ambiguous and at worst meaningless. Uncoated chocolate does not have a gloss, which is why high quality confections are currently glazed with wax or shellac as a final step in production. See, e.g., specification at page 1, paragraph 0002. Accordingly, Applicants maintain that the Action has failed to present a prima facie case that the coatings of Best render the present claims obvious.

While the above is believed to adequately address the rejection, for extra measure, Applicants note that Best is not prior art to the present application and therefore cannot form the basis for a rejection of the claims under §103(a). Applicants respectfully note that the filing date

of Best is December 2, 2003, less than one year before the March 1, 2004 filing date of the application under examination. Accompanying this Amendment is the Declaration of Dr. Kirsten L. Danganan. In her Declaration, Dr. Danganan states that she formed gloss coatings using sucrose and a variety of proteins, including several different whey protein concentrates, and found that the whey protein concentrate coating were "the most mirror-like". These experiments were performed in the United States in her laboratory at the University of California at Davis. She further declares that, while the dates in the notebook have been redacted, they are before December 2, 2003.

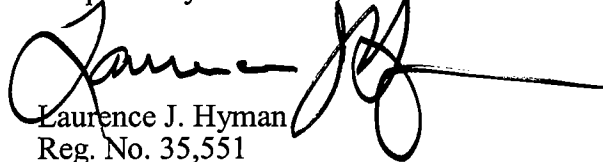
The invention was thus reduced to practice in the United States before the filing date of Best. Best is therefore not a reference against the present claims for purposes of §102(e), or for purposes of §103(a). Reconsideration and withdrawal of the rejection is respectfully requested.

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

  
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